

Application No.: 10/797,401
Amendment dated: September 20, 2010
Reply to Office Action of: **March 19, 2010**
Atty. Ref.: 501120-014

REMARKS

This responds to the **March 19, 2010** non-final Office Action.

In the non-final Office Action, claims 1-5, 7, 8, 10-23 and 29-33 are noted as pending in the application, the specification is objected to, the drawings are objected to, claims 1-5, 7, 8 and 10-13 are rejected under Section 112, first paragraph, claims 1-5, 7, 8 and 10-13 are rejected under Section 112, second paragraph, claims 1-5, 7, 8, 10, 13 and 21-23 are rejected as being unpatentable over U.S. Patent 4,405,058 (*Phalin*) in view of U.S. Patent 3,942,673 (*Lyu*), and claims 14-18, 19-20 and 29-33 are allowed.

Applicant appreciates the allowance of claims 14-20 and 29-33.

In response to the non-final Office Action, claims 1, 5, 8 and 21 have been amended, claims 4 and 11-13 have been cancelled without prejudice or disclaimer, new claims 39-53 have been added, and the drawings and the specification have been amended.

Objections to the Specification

The specification was objected to because there was no proper antecedent basis for the following limitation in claims 1, 11 and 12: "a recess portion having an interior area extending toward the center of the receptacle and an exterior area extending away from the center of the receptacle." This limitation has been deleted from claim 1 and claims 11 and 12 have been cancelled without prejudice or disclaimer. Accordingly, Applicant respectfully contends that this objection is moot.

Objections to the Drawings

The drawings were objected to because the raised center portion of the base having a height approximately half the height of the outer wall portion was not shown. In response thereto an additional new drawing figure (FIG. 6a) has been added to a new sheet 7. The specification has been accordingly amended to mention this new drawing figure.

Rejections of Claims under 35 U.S.C. 112, First Paragraph

Claims 1-5, 7, 8 and 10-13 were rejected as failing to comply with the written description requirement. The Office Action said that it was unclear what was intended in independent claims 1, 11 and 12 by the recitation of "a recess portion having an interior area extending toward the center of the receptacle and an exterior area extending away from the center of the receptacle." This limitation has been deleted from claim 1 and claims 11 and 12 have been cancelled without prejudice or disclaimer. Accordingly, Applicant respectfully contends that these rejections are moot.

Rejections of Claims under 35 U.S.C. 112, Second Paragraph

Claims 1-5, 7, 8 and 10-13 were rejected as being indefinite. The Office Action said that Applicant had failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention in independent claims 1, 11 and 12 by the recitation of "a recess portion having an interior area extending toward the center of the receptacle and an exterior area extending away from the center of the receptacle." This recitation has been deleted from claim 1 and claims 11 and 12 have been cancelled without prejudice or disclaimer. Accordingly, Applicant respectfully contends that these rejections are moot.

Rejections of Claims under 35 U.S.C. 103

Claims 1-5, 7, 8, 10, 13 and 21-23 were rejected as being unpatentable over *Phalin* in view of *Lyu*. These rejected claims include four independent claims, namely, claims 1, 11, 12 and 21. Claims 11 and 12 have been cancelled herein. Claims 1 and 21 have been amended and new independent claims 40, 45 and 46 have been added. Applicant respectfully contends that independent claims **1, 21, 42, 45 and 46** as well as all of the claims depending from them, are patentable over *Phalin* in view of *Lyu* for the various reasons discussed below.

1. Brief Description of Exemplary Receptacle Embodiment

A novel and improved receptacle for preparing a beverage with drinkware whose rim is coated with a spice, for example a dry granular, flaked, shaved or powdered substance is disclosed in the subject application. For example, the receptacle will hold the spice and use gravity to more efficiently use the spice, reduce waste and to more completely coat the rim of the drinkware.

The container 1 may include a dome or other raised surface extending toward the center point 4 of the container (FIG. 6). The raised portion gradually descends toward the perimeter of the container terminating at a preferably flat inner portion extending outward and forming a well, recess or other lower, collecting portion, labeled in the application as a level plane 6. The spice collects at the level plane 6 through gravity. The level plane is flat for a sufficient distance (radially, for example) to allow enough spice to reside in the level plane for coating the rim of a drinkware. The level plane permits a quantity of spice to rest on the level plane and form a quantity of spice having a relatively constant depth across the extent of the level plane. As a result, dipping a rim in any portion of the level plane will produce the same amount of coating on the drinkware rim for any location in the level plane, assuming the spice is level. The raised portion may be a continuous and smooth surface with a constant curvature, or may have other configurations.

The outer wall of the receptacle extends upwardly from the level plane 6 to the rim 12. The outer wall is high enough to contain the spice. The internal dimensions of the outer wall are preferably large enough to accommodate most sizes of drinkware, and the outer dimensions of the raised portion in the example shown in the specification are small enough to accommodate most sizes of drinkware without the drinkware rim contacting the raised portion when the drinkware is centered in the receptacle. By way of example, conventional drinkware may have opening diameters of about four inches, plus or minus about two inches. The height of the outer wall is preferably at least as high as the depth of the application of spice to the drinkware rim, for example about 1/4 inch. The height of the outer wall may be about twice the vertical height of the raised portion, and the height is about four times the vertical height of the raised portion in the

configuration shown in FIG. 1. As noted in the specification, the drawings show the relative dimensions to scale. The height of the outer wall may, for example, be about two inches.

In the exemplary embodiment shown in FIG. 1, the height of the raised portion is about 25% of the height of the outer wall, and in the exemplary embodiment the outer wall would be two inches high and the raised portion would be about one-half inch. As noted in original claim 9, the outer wall is higher than the raised portion, and in original claim 10, it is at least twice the height of the raised portion. The raised portion may have a dome shape defining a circle having a diameter of two to four inches. The diameter of the opening or mouth of the receptacle is greater than the height of the receptacle. The receptacle may be formed, for example by molding, from food grade materials, including plastics, and the like. [See paragraph [0027]]

2. Phalin was Mischaracterized in Section 103 Rejection

U.S. Patent 4,405,058 ('058) discloses two separate and independent pieces of prior art. (1) The first is a 24-ounce 404 X 307 steel container (Col. 1, lines 49-55) made in a two draw operation and having a diameter greater than the height and hereinafter referred to as the "404 X 307 steel container." (2) The second is the "Phalin container," as shown in FIG. 4, and having a height greater than its diameter, e.g., a height of about 4.425 inch and an inside diameter of about 3.805 inch. (Col. 9, lines 10-13.)

Applicant respectfully notes that no receptacle having the configuration of the receptacle of FIG. 2 including the bottom configuration of reference numeral 53 and having a diameter greater than its height is disclosed in the '058 patent. In other words, Phalin does not disclose a (steel) container having a diameter greater than its height and having a bottom configured as shown by reference numeral 53.

It appears that if the Section 103 rejection were to be properly (re)stated it would be a rejection over the Phalin container (whose height is greater than its diameter) and having a bottom configuration 53, modified in view of the 404 X 307 (steel) container (so that its diameter is greater than its height), and then further modified in view *Lyu*; in

other words, the "Phalin container" in view of the 404 X 307 steel container and further in view of *Lyu*.

Applicant respectfully traverses that hypothetical rejection. The '058 patent specifically teaches that the "Phalin container" has a height greater than its diameter (e.g., a height of about 4.425 inches and an inside diameter of about 3.805 inches. (Col. 9, lines 5-8)) and does not have a diameter greater than its height. The limitations in a prior art reference must be arranged or combined in the same way as that recited in the claim. *Therasense Inc. v. Becton, Dickinson and Co.*, 593 F.3d 1325 (Fed. Cir. 2010)

It then states that it has long been desired to be able to make a container whose height is appreciably greater than the diameter, using precoated starting material in a multiple draw process.

Phalin specifically states that the intended goal of the "Phalin container" is for it to be taller than it is wide, which leads away from modifying the "Phalin container" so that it is wider than tall, and thus is strong evidence of nonobviousness.

Accordingly, one would not modify the "Phalin container" in view of the 404 X 307 (steel) container, and claims **1-3, 5, 7, 8, 10, 21-23, 34-45 and 53**, all of which include the feature that the receptacle is wider than it is tall, are patentable.

3. Modification of *Phalin* in View of *Lyu* was Improper

If one were to modify the bottom 53 of the Phalin container in view of *Lyu*, it is first submitted that one would not pick and choose different components, aspects, and/or dimensional relationships of the *Lyu* bottom wall 14. Rather, one would replace the entire bottom 53 with the *Lyu* bottom wall 14.

Lyu's bottom configuration must comply with the stated specifications (i.e., arcuate portion, dome height and diameter, and overall diameter) and none of these specification or dimensions can be overlooked or singularly taken out of context (Col. 3, lines 16-40). The Office Action does not provide any reasoning as to why one would pick and choose only certain aspects of *Lyu* bottom wall 14, unless one is employing impermissible hindsight.

Accordingly, claims **1-3, 5, 7, 8, 10, 21-23, 34-37 and 46-53** are patentable.

4. Rejections of *Phalin* in View of *Lyu* are Traversed

The rejections of independent claims 1 and 21 rely on *Lyu* having a raised portion (dome) extending $\frac{1}{2}$ " for a receptacle with a diameter of 3.5". However, the dome in the present application has two dimensions, namely, a height (relative to the sidewall) and a fixed diameter that is not relative to the overall diameter. *Lyu*'s bottom configuration (diameter and height of the dome) has no relationship to the side wall height and most significantly *Lyu*'s diameter of the dome increases as the diameter of the container increases. An analysis of the *Lyu* prescribed dimensions, reveals that six and seven inch diameter configurations both require a dome diameter that exceeds four inches. In contrast, Applicant's examples and claims have a dome diameter between two and four inches, substantially less than that of *Lyu*.

Referring to the rejection of claim 12 (now cancelled), the example of a container with a diameter of four inches is typically smaller than the diameter of a container that Applicant would use and thus is not relevant. Pursuant to claim 1, the dome diameter is diameter between approximately two inches and approximately four inches and an analysis of *Lyu* reveals that a container that exceeds four inches exceeds the limited range of the dome diameter.

Referring to the rejection of claim 14, the examples (and citing of all art) are for containers that are taller than wide, and *Phalin* is limited to a container that is 4.25 inches which renders containers that are wider (larger diameter) outside of the scope conceived by *Phalin* and *Lyu* (*Lyu* in context of the dimensions of the raised dome).

Accordingly, claims **1, 12, 14, 21, 40, 45 and 53** are patentable.

Further, Applicant respectfully contends that one would not make the dome diameter of *Lyu* between two and four inches by making the container diameter smaller for the following reasons.

Applicant's receptacle has a sufficiently wide diameter so that common drinkware can fit inside the receptacle to access the receptacle's contents and apply about the rim of an item of drinkware. Further, the dome within the receptacle must have a sufficiently

small diameter so that the dome does not interfere with the drinkware rim when introduced into the receptacle. *Lyu* specifically teaches away from this dimensional concept, since as the diameter of *Lyu*'s container increases the diameter of his dome must also increase proportionally. See Col. 3, lines 18-33.

5. Flat Surface is Not Taught by Lyu

Replacing the bottom 53 of the Phalin container with the *Lyu* bottom wall 14 does not teach a flat surface. Rather, *Lyu* discloses a rounded and not a flat surface. *Lyu* specifically discloses that the side wall 12 is joined to the bottom wall 14 through an arcuate portion 16 having a progressively decreasing radius which merges with the bottom wall through an annular outwardly directed bead 18. This is shown in FIG. 2 of *Lyu*. This is not a "substantially flat surface" as claimed in claims 1 and 46, or a "relatively flat section" as claimed in claims 21 and 45, or "flat" surface as claimed in claim 41.

Accordingly, claims 1, 21, 41, 45, 46 and all those depending from them are patentable.

6. Claimed Receptacles for Receiving Granular Material to be Placed on an Open Rim of a Beverage Container or Item of Drinkware are Not Rendered Unpatentable by Prior Art Steel Cans

None of 404 X 307 steel container, Phalin container or *Lyu* discloses an open top container such as Applicant's receptacle for receiving granular material to be placed on an open rim of an item of drinkware or beverage container wherein the receptacle has a top rim forming an open receptacle opening. Rather, each discloses an enclosed can having a top end closure. The can body of the Phalin container, for example is flanged so that the packer can apply a top end closure to it.

In contrast, both of independent claims 1, 42 and 46 are directed to a receptacle for receiving granular material to be placed on a rim of a beverage container or an item of drinkware.

New independent claim 42 specifically states that: "the raised dome portion being configured to allow a granular material to move under the force of gravity from the raised dome portion toward the surrounding portion; and the surrounding portion being configured to support the granular material and being sized sufficiently to receive an open rim of a beverage container inserted in through the receptacle opening."

Similarly, new claim 41, which depends from claim 21, states "wherein the raised portion is configured to allow a granular material to move under the force of gravity toward the relatively flat section, and the relatively flat section is configured to support the granular material and is sized sufficiently to receive an open rim of a beverage container." Additionally, claim 21 says that "the rim defines an opening having a size sufficient to receive the open rim of an item of drink ware."

Thus, independent claims **1, 21, 42 and 46** and all of the claims depending from them (including **41**) are patentable.

7. Plastic Receptacles Are Not Taught by Prior Art

All of 404 X 307 steel container, the Phalin container and Lyu are steel containers, while claims 21, 35, 44 and 45 say that the present receptacle is made of plastic. One would not modify any of these prior art containers to make them out of plastic, Applicant respectfully contends, as they would not then have the sturdiness to withstand the filling process, the pressurized contents and/or the rough handling to which they are subjected without breaking or leaking.

On the other hand, it is desirable to make the subject "rimming" receptacles out of molded plastic instead of drawn and ironed steel because steel articles that are exposed to moisture and standing water, which are often found in a bar/food service environment, will rust. Additionally, steel, tin and other metals when in contact with food items that contain salt and/or sugar are susceptible to corrosion and further can contaminate food items they contact. Additionally, molded plastic containers are cheaper and easier to manufacture than are stainless steel containers.

Thus, claims **21, 22, 23, 38-41, 44 and 45** are patentable.

8. Threads or Snap-On Protrusions on Upper Outer Surface of Wall are Not Taught by Prior Art

Referring for example to Figure 6, the receptacle can have threads to secure a lid to it, the threads being positioned on an upper outer surface of the wall. This is not taught by the cited prior art. In contrast, the cited prior art deals with internal pressures for which removable lids are not used.

Thus, claims **38, 40 and 43** are patentable, as is claim **37** which includes snap-on protrusions on an upper outer surface of the outer wall portion and spaced below the rim. Claim **45**, which is essentially claim 22 plus an additional last paragraph, is also patentable.

9. Claim 46 is Patentable

Claim 46 includes:

"a container having an upper rim defining a container opening, an outer wall portion extending vertically downwardly a first distance from the upper rim to a base portion, wherein the first distance is between one-quarter inch and two inches, the base portion having a substantially flat surface facing upwardly toward the container opening and extending inwardly toward a center from the outer wall portion to a raised portion, wherein the raised portion extends inwardly from the base portion substantially constantly upwardly toward a center of the receptacle and wherein the raised portion has a vertical height approximately half the first distance; and

"a rimming dish sized to fit at least partly within the container, the dish having a first recessed area for receiving a coating material for coating a rim of a beverage container,"

This claim is not taught by the prior art, Applicant respectfully contends.

Thus, claim **46** and dependent claims **47-53** are patentable.

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10. Dependent Claim 47 is Patentable

Claim 47 includes that the rimming dish "has a raised area that includes a wall defining an outer perimeter of the raised area and wherein the raised area further includes a second recessed area within the wall." This is not taught by the prior art.

Thus, claim **47** and claims **48-52** depending from it are patentable.

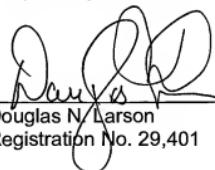
Concluding Remarks

Reconsideration of the application and claims in view of the foregoing amendments and remarks is respectfully requested. It is believed that all claims are now in a condition for allowance, and early notice to that effect is respectfully requested.

If the Examiner does not believe the foregoing amendments place the subject application in a condition for allowance, the below-signed counsel for Applicant respectfully requests the courtesy of a telephone interview to discuss any remaining issues.

If a petition is required in conjunction with this paper, please consider this a request for such a petition.

Respectfully submitted,



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